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Patent
Attorney's Docket No. 012627-029

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
	)	
Konrad HERMANN et al.	)	Group Art Unit: 1624
	)	
Application No.: 09/830,518	)	Examiner: John M. Ford
	)	
Filed: March 15, 2002	)	Confirmation No.: 8211
	)	
For: Polycyclic Pyrimidine-2,4(1H,3H)-diones with Functionalized Alkyl Residues at the 1- and/or 3-Position(s); Methods for Their Synthesis and Pharmaceutical Preparation	)	

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully traverse the restriction requirement set forth in the Office Action dated March 18, 2003.

In the Office Action, the Examiner sets forth a restriction requirement between two groups of claims:

I. Claims 1, 2, 5 and 6 drawn to pyrimidines and a use thereof.

II. Claims 3 and 4 drawn to multiple methods of making the compounds.

Applicants respectfully assert that the inventions of Group I and Group II should properly be examined together. The invention of Group I is directed to a pyrimidines and a use thereof and the invention of Group II is directed to a process for making these compounds. Therefore, the inventions of Group I and Group II are closely related.

The Examiner contends that the inventions of Group I and Group II are patentably distinct because the compounds claimed can be made by more than one process.

Applicants submit that the inventions of Groups I and II are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly

outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the two inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

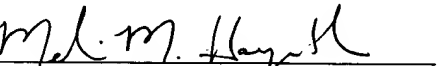
Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicant provisionally elect, with traverse, to prosecute the invention of Group I, namely claims 1, 2, 5, and 6, for prosecution in the above-identified application.

Applicants expressly reserve the right to file a divisional application covering the subject matter of the non-elected claims.

Applicants earnestly solicit favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
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